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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/807,227 | 03/22/2004 | Kinam Park | 368-011C | 1689 |

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JAMES H. MEADOWS AND MEDICUS ASSOCIATES
2804 KENTUCKY
JOPLIN, MO 64804

| EXAMINER | |
|---|---|
| COONEY, JOHN M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1711 | |

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/807,227 | PARK ET AL. | |
| | Examiner | Art Unit | |
| | John m. Cooney | 1711 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-40 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 22 March 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 0304.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

In the oath filed, the at least one error is described as "Failure to make reference to a prior copending application". However, there is no indication as to how this renders the original patent wholly or partly inoperative or invalid (see M.P.E.P. 1414 II). A suggested statement might read: "Failure to make reference in the first sentence of the specification to a prior copending application renders the original patent wholly or partly inoperative or invalid because priority under 35 U.S.C. 120 was not adequately claimed."

Claims 1-40 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by DE-195 40 951 (corresponding to USPAT 6,136,873)(Hereon referred to as HAHNLE et al.).

HAHNLE et al. disclose preparations of superabsorbent polymeric hydrogel composite materials prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents reading on the materials of applicants' claims (See HAHNLE et al. in its entirety). [ – Note also – the following cites from USPAT 6,136,873 {for informational purposes only} pertaining to English language recitations of the later US equivalent – abstract, column 1 lines 12-16, column 2 line 24 et seq., column 3, column 5 line 26 et seq., column 6 lines 1-9, column 8 lines 49 et seq., column 9 lines 1-30, column 10-13, column 14 lines 1-6, and the examples - ].

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of HAHNLE et al. and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the degree defined by applicants' claims is held to be inherent to the teachings of HAHNLE et al.

Regarding applicants' claim of priority, it is noted that if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 USC 112 in the parent non-provisional application, but which was first introduced or adequately supported in the continuation-in-part

application such a claim is entitled only to the filing date of the continuation-in-part application {See M.P.E.P. 211.11 VI }. Such is the case here. The 5,750,585 patent does not adequately disclose the broadly or specifically defined disintegrant materials of the instant claims. Additionally, it is not seen that applicants' method claims which set forth the generically defined term "disintegrant" are adequately disclosed and/or envisioned by the 5,750,585 patents' suggestive disclosure of fillers for strengthening and/or absorbance purposes (see column 6 lines 40-51 of the 5,750,585 patent). This disclosure is not seen to adequately disclose the invention of the instant claims.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Phan et al.(5,506,035).

Van Phan et al. disclose preparations of superabsorbent crosslinked composite polymer network materials which are insoluble in water but swell to an equilibrium size in the presence of excess water {hydrogel} and are prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents reading on the materials of applicants' claims (See the abstract, column 6 line 34 et seq., column 7, column 8 lines 1-53, and column 10 lines 35-60, as well as, the entire document).

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of Van Phan

et al. and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the degree defined by applicants' claims is held to be inherent to the teachings of Van Phan et al. Further, the cellulosic disintegrant materials and broader group of disintegrant materials of applicants' claims are not seen to differ from the cellulosic materials and larger group of viscosity control agents of Van Phan et al. in a patentable sense.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8-16, 18-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,750,585. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 5,750,585 patent claims disclose crosslinked hydrogel matrix materials as claimed by applicants but differ in that

disintegrants are not particularly recited. However, looking to 5,750,585's disclosure for definition of practicing the procedures of the claims identifies the inclusive embodiment of fillers (see column 6 lines 40-51) which include materials meeting the definition of the broad term "disintegrant" and disintegrant component (v.) of applicants' claims. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the absorbent materials of 5,750,585's disclosure for the purpose of imparting their absorbent effect in the preparations of the claims of 5,750,585 in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The required showing of new or unexpected results has not been made and/or is not seen.

Additionally, as the record currently stands, it is seen that the above rejection is properly set forth along with the above denial of 5,750,585's effective filing date for all of the claims, because, although adequate disclosure of the generically defined "disintegrant" materials for the reasons set forth above is lacking , suggestion for obviousness for the reasons set forth above is seen to be evident.

However, if the record establishes that adequate support for the broad term "disintegrant" is provided for by this disclosure, then the rejection of claims 33-40 over the HAHNLE et al. reference will be withdrawn and the above Double Patenting rejection maintained.

Claims 1-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 17,18, and 20-30 of copending Application No. 10/420,323. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 10/420,323 disclose crosslinked hydrogel matrix materials as claimed by applicants which employ strengthening materials which overlap with the disintegrant materials in a manner which would have been obvious to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the above rejection is set forth as a provisional rejection, it should be treated as if it is non-provisional because the claims of 10/420,323 have passed to issue and will be assigned a patent number in due course.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Langer et al.(6,224,893) and Hahnle et al.(6,174,929) are cited for their disclosure of interesting materials in the related arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700